

REMARKS

1. The Application has Claims 1-38 pending. The amendment filed on January 5, 2004 was not entered. The present amendment replaces the non-entered amendment of January 5, 2004. Claims 1-38 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,219,654 to Michael Ruffin ("Ruffin"). Claims 1, 6, 8, 9, 12, 13, 15, 18, 20, 22, 27, 30-34 and 37 have been amended in a non-narrowing manner to clarify what is being input, evaluated, and output in the claimed system and method. Support for the amendments is found at least in the claims as filed, in Fig. 11, in the specification at p. 2, lines 15-22; p. 6, lines 1-8; p. 14, lines 22-27; p. 15 line 30, to p. 16, line 9; p. 18, lines 19-23; and p. 18, lines 26-28. No new matter was added in amending the claims.

2. A brief telephonic interview was conducted between the undersigned and Examiner Colon on February 2, 2004. Claims 1 and 18 were discussed. Examiner Colon stated that she believed that at least some of the amended claims overcame the prior art, Ruffin, but that the amendment would require a new search because of the use of the claim term "structure." The undersigned pointed out that the term "structure" was already in use in the claims as filed and in the claims after the amendment filed on August 19, 2003. The Examiner refused to enter the amendment and recommended a request for continued examination be filed. The Examiner is thanked for the courtesy in allowing the interview.

3. Applicants assert that the present amendments overcome the rejections of Claims 1-38 under 35 U.S.C. § 102(e) in view of Ruffin. Ruffin is directed to performing cost analyses for an information technology (IT) implementation. In contrast, the present application is directed to a computerized method for evaluating and shaping a business proposal, under one or more structures for the proposal. The Examiner cites passages in Ruffin as anticipating the limitations of the claims in the present application. As noted below, Ruffin fails to anticipate at least one element of each independent claim of the present application, Claims 1, 18 and 32.

4. As concerns amended Claim 1, the rejection cites Ruffin, col. 2, lines 29-33, and col. 3, line 10 to col. 4, line 12, for the claim limitation of “gathering information.” These passages do not disclose all the limitations of this step of the claimed method. The passages cited do not describe or teach at least the limitations of gathering the following information: “descriptive information,” “business issues,” “business goals,” “methods of achievement of the proposal,” and “an innovation value of the proposal.” Thus, Ruffin does not anticipate Claim 1 for at least this reason

In addition, the fourth limitation of amended Claim 1 is a step of “ranking the structures,” which is not disclosed or suggested by Ruffin. The Office Action cites Ruffin, col. 16, lines 1-24, and Fig. 9, as anticipating this claim limitation. The passage from Ruffin concerns a computer assessment technique for customer needs, and Fig. 9 from Ruffin is a process flow for computer evaluation involving customer profile scores. The fourth claim limitation, however, claims a step for ranking particular structures, the structures of the proposal defined in the first claim limitation as one of “an alliance, an acquisition, an equity venture, a partnership, or a venture.” The passage and figure cited from Ruffin do not describe or suggest any of these structures.

Moreover, Ruffin does not disclose ranking alternative business structures for a proposal, but discloses a proposal from a single business structure – that of a traditional information technology solution provider in a consulting and sales relationship with a customer. The Examiner cites Fig. 9 of Ruffin, which discloses rankings of various technical offerings. This does not suggest ranking a plurality of business structures as recited in Claim 1. Thus, Ruffin does not anticipate at least the fourth limitation of Claim 1.

Ruffin does not describe or disclose at least these limitations of independent Claim 1, and therefore Claim 1 and its dependent claims, Claims 2-17, are believed to be allowable. Accordingly, the Examiner is requested to withdraw the rejections of Claims 1-18 under 35 U.S.C. § 102(e).

5. Claims 18-31 are also rejected as anticipated by U.S. Pat. No. 6,219,654 to Michael Ruffin (“Ruffin”). The rejection cites Ruffin as disclosing each limitation of

Claim 18 and of dependent Claim 19-31. Ruffin does not disclose proposing structures for a business proposal, structures as defined in the present application as a form of business, such as an alliance, an acquisition, an equity venture, a partnership, or a venture. In the passage cited from Ruffin, col. 2, lines 29-33 and col. 3, line 10, to col. 4, line 12, the discussion concerns the structure of the information technology (IT) system that will be proposed. Ruffin, col. 3, line 65, to col. 4, line 2. Ruffin does not disclose the structures claimed in Claim 18. The discussion of business in the rejection of Claim 18, on p. 8, lines 9-15, of the Office Action, is taken not from Ruffin but from the text of Claim 18 itself. To show anticipation, the anticipating disclosure must be found in the reference, not in the patent application being examined.

As discussed in the above paragraph concerning Claim 1, Ruffin does not disclose all the limitations of the step of "searching at least one database for information," because Ruffin does not disclose the particular limitations concerning the types of information sought. The passages cited by the Examiner do not disclose at least these limitations of this step: cost drivers; revenue drivers; risks of the business proposal; and "a competitive advantage."

As to the rejection of the third step of the claimed method, proposing at least two structures for the business proposal, the rejection fails to show that Ruffin discloses this third step of Claim 18. Ruffin is directed to a method for proposing IT systems to customers, so that customers will purchase IT systems from the vendor who proposes the system. But the Office Action states that "businesses often form ventures, alliances or partnerships in order to gain access to expertise/resources they are currently lacking, such as information technology." Office Action, p. 8, lines 12-15. The Office Action cites to no passage in Ruffin for this assertion, which goes well beyond the disclosure of Ruffin for "determining the cost to an enterprise of a proposed information technology implementation." Abstract, lines 1-3. Thus, Ruffin does not disclose the third step of Claim 18, "proposing at least two structures."

Ruffin also does not disclose the last step of the method, the step of calculating an advantage of the several structures of the particular proposal under consideration. The passage cited in the rejection, col. 10, lines 25-38, concerns providing an analysis

of a particular technical IT solution, not the claimed limitation of providing several possible business structures for a business proposal, showing the ways to structure the proposal, and then calculating an advantage from each of the structures proposed. Accordingly, Ruffin does not disclose at least these limitations of Claim 18.

Ruffin also does not disclose ranking the structures as claimed in Claim 27. Fig. 9 from Ruffin, and the passage cited, col. 16, lines 1-53, concern evaluation of "islands." These "islands," however, are not alternate or different structures, since the customer's IT network is divided up into islands, in which each island is "a group of IT resources which have a logical reason for being viewed and analyzed as a single entity." Col. 12, lines 50-52. Each island is then analyzed and a solution proposed; if the islands are too large, the task takes too long; if the islands are too small, the proposed solution is likely too straightforward and does not require customer input. Col. 12, lines 52-65. The cited passage does not disclose a step of "calculating an advantage of the structures." Claim 18 and its dependent claims, Claims 19-31, are therefore allowable. Accordingly, the Examiner is requested to withdraw rejections of Claims 18-31 under 35 U.S.C. § 102(e).

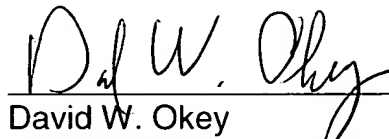
6. Independent Claim 32 and dependent Claims 33-38 claim a computer system for evaluating a proposal and contain limitations similar to those in Claims 1 and 18. As mentioned above in the arguments for Claim 1, the rejection cites Ruffin, col. 2, lines 29-33, and col. 3, line 10 to col. 4, line 12, for the claim limitation of "gathering information." These passages do not disclose all the limitations of this portion of the claimed system. The passages cited do not describe at least the limitations of: "descriptive information," "business issues," "business goals," "methods of achievement of the proposal," and "an innovation value of the proposal."

Similarly, Ruffin does not disclose all the limitations of the claimed "computer program" of Claim 32, because the passages cited in the rejection do not disclose the particular structures claimed in Claim 32. The argument given in the rejection also goes beyond what is fairly suggested by the Ruffin reference as a whole, since the rejection states that "businesses often form ventures, alliances or partnerships in order to gain access to expertise/ resources they are currently lacking such as information

technology.” Office Action, p. 12, lines 1-3. As mentioned above, Ruffin is directed to providing IT solutions from a traditional IT solutions vendor to a customer, and does not disclose or discuss the business structure of a proposal, providing for alternate structures, and then ranking or evaluating structures. Accordingly, Independent Claim 32 and dependent claims 33-38 are not anticipated, and the Examiner is requested to withdraw the rejections under 35 U.S.C. § 102(e).

7. The Examiner is requested to enter the amendment and corresponding remarks and to withdraw the rejections under 35 U.S.C. § 102(e). Applicants have shown how the cited reference does not anticipate the claims of the application. Applicants have also amended the claims in a non-narrowing manner to more specifically claim elements of the invention, and have amended the specification to correct grammatical and spelling errors. The Examiner is respectfully requested to call the undersigned if the call will be of assistance to the Examiner or will expedite the allowance of the claims in this case.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "D. W. Okey", is written over a horizontal line.

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